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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,636	05/22/2001	Ervin Goldfain	281-329.02	1483

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EXAMINER
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SANDERS JR, JOHN R

ART UNIT	PAPER NUMBER
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3735

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/862,636

Applicant(s)

GOLDFAIN ET AL.

Examiner

John R. Sanders

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22,46-122 and 124-150 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22,46-122 and 124-150 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/13/06
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 13 April 2006 have been fully considered but they are not persuasive.
2. Applicant argues that Examiner has provided an omnibus rejection. Examiner respectfully disagrees. Applicant argues that the rejection is not equally applicable to the various groups of claims designated in the rejection, and that Examiner has not designated the particular parts of the references relied upon, arguing that the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.
3. It is clear from the application that the independent claim groups constitute subcombinations of elements that are used, in each subcombination, for the express purpose taught by the prior art. The applied references show these elements and are discussed in the rejection below. Their pertinence to the claims is apparent.
4. Applicant argues that since not every independent claim makes reference to each element specified in the rejection, that the presented rejection is not equally applicable to each claim. Examiner respectfully disagrees. Applicant argues that the rejection with reference to a module attachment cannot apply to independent claims 84, 100, 116, 132, 138, and 144, since said claims make no mention of a module attachment. However, it is clear from the dependent claims 85, 101, 117 and 133, which do in fact recite a module attachment, that the scopes of the claim groups are comparable. Applicant argues that claims 1, 46, 84, 100, 116, 132, and 138 make no reference to a hand held housing. However, clearly the preambles of claims 84, 100, 116, 132 and 138 recite "A hand held retina viewing device," and dependent claims 52 and 59-66 all recite

Art Unit: 3735

hand held functionality. Regarding the aperture stop limitation, the same applies: although Applicant alleges that claims 1, 46, 71, 84, 100, 116, and 138 do not include an aperture stop, clearly 84, 100, 116, and 138 actually do recite such an element, and dependent claims 57 and 82 are also indicative that the scopes of the claim groups are comparable. Furthermore, the claims are written in inclusive or open-ended transitional terms such that additional, unrecited elements or method steps are not excluded from the claims. *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004). See MPEP §2111.03. Thus, the rejection cannot be said to not apply to a claim when the rejection may state elements that are not present in the claim.

5. Finally, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (see page 32, ¶3) it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, portable functionality, the objective lens curvature/aperture stop limitations, *as well as the motivations for each* are expressly disclosed by the references (Taylor: col. 3, lines 17-33; Takhashi: col. 2, lines 61-67; see also rejection below).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-22 and 46-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,944,342 to Martinez ("Martinez") in view of U.S. Patent No. 5,125,730 to Taylor et al ("Taylor") and further in view of U.S. Patent No. 4,704,018 to Takhashi ("Takhashi").

9. Martinez discloses a photographic apparatus for eye viewing with a slit-lamp wherein one ocular of a binocular microscope of the slit lamp is replaceable by a photographic camera module attachment (Figs. 2-3) via a mating connector (146, 152) and wherein electrical

Art Unit: 3735

connection is made between the slit-lamp and the camera attachment via a coaxial cable (136, 138; col. 5, lines 41-64).

10. Martinez does not expressly disclose a hand-held apparatus or said camera as an image sensor generating image signals. Taylor teaches a portable fundus camera (Fig. 5) comprising a CCD device (32) image sensor that generates image signals. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the device of Martinez to be hand-held and to replace the conventional film camera with a CCD imager, in order to add portable functionality and to enable electronic imaging, respectively, both teachings being common in the art and expressly taught by Taylor. Furthermore, it has been held that the fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results. *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952).

11. Martinez does not expressly disclose an aperture stop and an objective lens wherein a surface of said lens closest to the light source is curved concentrically about the center of the aperture stop.

12. Takhashi teaches an objective lens (L2) whose surface closest to light source (L) has a center of curvature that is coincident with the position of aperture stop (D). See also Fig. 2. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Martinez in view of Takhashi to include an objective lens with a anterior surface shaped sufficiently concentric about an aperture stop in order to reduce or eliminate reflections from surfaces within the device (Takhashi: col. 2, lines 60-67).

Art Unit: 3735

13. Claims 84-122 and 124-150 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takhashi in view of Taylor.

14. Takhashi teaches an eye fundus observing and photographing apparatus wherein a moveable mirror (M2) is operable to select between an imaging path and an observation path (Fig. 1). Takhashi also teaches an objective lens (L2) whose surface closest to light source (L) has a center of curvature that is coincident with the position of aperture stop (D), in order to reduce or eliminate reflections from surfaces within the device (Takhashi: col. 2, lines 60-67). See also Fig. 2.

15. Takhashi does not expressly disclose a hand-held apparatus an image sensor generating image signals. Taylor teaches a portable fundus camera (Fig. 5) comprising a CCD device (32) image sensor that generates image signals. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the device of Takhashi to be hand-held and to replace the conventional film photographing apparatus with a CCD imager, in order to add portable functionality and to enable electronic imaging, respectively, both teachings being common in the art and expressly taught by Taylor. Furthermore, it has been held that the fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results. *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952).

16. Regarding claims 85, 101, 117, 133 and 139: The limitations to a holder receiving a replaceable module comprising an element of the device (moving mirror, beam splitter, etc.) is not considered patentable over the prior art since it has been held that merely making elements

Art Unit: 3735

separable does not constitute a non-obvious improvement over the art. *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961).

### ***Conclusion***

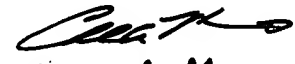
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Sanders whose telephone number is (571) 272-4742. The examiner can normally be reached on M-F 10:00 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
JRS

31 July 2006

  
Charles A. Marmor, II  
SPE, Art Unit 3735